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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,647	05/25/2007	Marinus Theodorus Gidding	067670-5012-US	1520
67374 7590 10/27/2010 MORGAN, LEWIS & BOCKIUS, LLP (SF) ONE MARKET SPEAR STREET TOWER SAN FRANCISCO, CA 94105				
EXAMINER FELTON, MICHAEL J				
ART UNIT 1747		PAPER NUMBER		
MAIL DATE 10/27/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/582,647

Applicant(s)GIDDING, MARINUS
THEODORUS**Examiner**

MICHAEL J. FELTON

Art Unit

1747

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 42-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 23 is/are rejected.
- 7) ☒ Claim(s) 8-22 and 24-41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/12/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of group I (claims 1-41) in the reply filed on 8/30/2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 42-51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The term "a maximum of 10% of the flow rate of the gas flow resulting from inhalation or exhalation" in claim 23 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In this case, it is unclear what the gas flow rate from inhalation or exhalation would be as it is a relative amount based on

the use of the article. Furthermore, one of ordinary skill would expect that the flow rate would of the inhalation or exhalation would approach 0, resulting in a forced air flow greater than 10% of the flow rate from exhalation/inhalation.

Claim Objections

6. Claims 8-22 and 24-41 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 8-22 and 24-41 have not been further treated on the merits.
7. Applicant should note that the phrase, "displacing means for generating one or more forced gas flows" in claim 3, and the phrase, "suction means" in claim 4, are interpreted as invoking the means plus function relationship as discussed in 35 U.S.C. 112, sixth paragraph. Therefore, the "means" in each case is interpreted to be the means as disclosed on page 3, lines 12-22 of the specification received on 6/12/2006.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

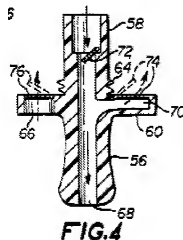
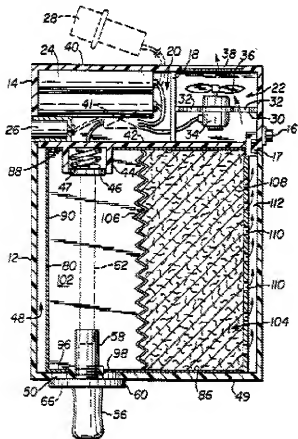
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims **1, 3, 4, 5, and 7** are rejected under 35 U.S.C. 102(b) as being anticipated by Rehder et al. (US 5,529,078).

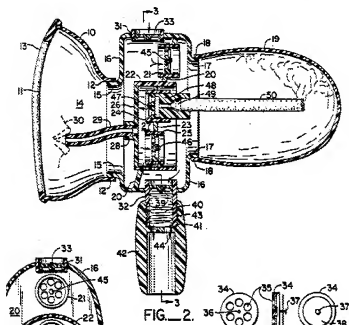
10. Regarding claims **1** Rehder et al. disclose a smoking apparatus as shown in figures 2 and 4 (inserted below) with:

- a. a tobacco reservoir (figure 2, element 62)
- b. an outside air feed (figure 2 and figure 4, element 66)
- c. a tobacco smoke discharge (figure 2, elements 102 (combustion/smoke chamber), 110 (vents), 112 (channel), 22 (compartment), and 38 (exhaust); see also col. 4, 48-62)
- d. a filter connected to the tobacco smoke discharge (figure 2, elements 106 (particulate filter), 104 (HEPA filter))



- e. a mouthpiece connected to the tobacco reservoir and smoke discharge such that a smoker can inhale the tobacco smoke from the tobacco reservoir, and can exhale the tobacco smoke to the tobacco smoke discharge (see figure 4, elements 68 (inhalation channel), 72 (check valve biased to open when smoker inhales), 74 (check valve biased to open and pass exhaled smoke from the smoker into chamber 102 and through the smoke discharge system; See also col. 3, 10—col. 4, 62).
11. Regarding claim **2**, Rehder et al. do not expressly disclose that the tobacco smoke discharge and tobacco reservoir are arranged relative to each other for generating as a result of convection one or more gas flows in the smoke discharge. However, Rehder et al. would inherently produce gas flows between the tobacco reservoir and the smoke discharge via convection produced by the fan.
12. Regarding claims **3, 4, 5, and 7**, Rehder et al. also discloses a fan for forcing gas flows in the smoke discharge system by which tobacco smoke is discharged. The fan is driven by an electric motor and powered with batteries in a compartment (figure 2, element 20).

13. Claims **1- 3 and 23** are rejected under 35 U.S.C. 102(b) as being anticipated by Waite (US 4,200,114).
14. Regarding claim **1**, Waite discloses an apparatus with a housing a filter, including
- o a tobacco reservoir (figure 2, element 19)
 - o an outside air feed (figure 2 and elements 45 and 33; col. 2, line 61)



- o a tobacco smoke discharge (figure 2, elements 39, 40, and 44; col. 2, line 61--col. 3, line 2)
- o a filter connected to the tobacco smoke discharge (figure 2, element 40)
- o a mouthpiece connected to the tobacco reservoir and smoke discharge such that a smoker can inhale the tobacco smoke from the tobacco reservoir, and can exhale the tobacco smoke to the tobacco smoke discharge (col. 2, line 61—col. 3, 22; col. 1, 14-30)

15. Regarding claim 2, convection inherently occurs in Waite between the tobacco reservoir and the smoke discharge during combustion of the tobacco as shown in figure 2 (see illustration of smoke).
16. Regarding claim 3, the gas displacing means used by Waite is the users lungs, which generate one or more forced gas flows in the smoke discharge.
17. Regarding claim 23, the convection flow created by the burning tobacco in Waite would be inherently result in flow rates lower than 10% of the flow rate during inhalation and exhalation.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rehder et al. (US 5,529,078) as applied to claim 1 above, and further in view of Fariello (US 3,804,100).

21. Rehder et al. disclose a fan for creating a gas flow through the smoke discharge system but do not disclose using a pump. However, it is well known in the art that pumps can also be used to produce gas flows through smoking apparatuses. For instance, Fariello discloses a pump to move gases between a combustion chamber and filter (water chamber) and mouthpiece. It would have been obvious to one of ordinary skill in the art at the time of invention to use a pump in place of the fan in the invention of Rehder et al. to produce gas flow through the smoke discharge system of Rehder et al. Doing so would have been well within the level of skill of one of ordinary skill in the art and the effects would have been predictable as fan and pump systems are well understood mechanical systems.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. FELTON whose telephone number is (571)272-4805. The examiner can normally be reached on Monday to Friday, 7:30 AM to 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Felton/
Examiner, Art Unit 1747

/Richard Crispino/
Supervisory Patent Examiner, Art Unit 1747